

### **REMARKS**

Claims 1-8 and 10-39 stand finally rejected. Applicants would like to point out that claims 1-39 (that is inclusive of claim 9) are pending in the Application. Attention is drawn to the Preliminary Amendment, filed June 20, 2003, adding claim 9. Claim 9 had been inadvertently left out of the original claim set and the original claim numbering proceeded from claim 8 to claim 10. The claim set that begins on page 2 of this reply indicates that claim 9 is "previously presented".

No claim amendments are offered with this reply.

Applicants respectfully maintain their position that the Examiner has applied the references inconsistently. Applicants believe that the references, considered as a whole, and in light of the comments offered here, do not anticipate or make obvious any of the rejected claims. Applicants respectfully request consideration of these comments after a Final Rejection.

### **REJECTIONS UNDER 35 U.S.C. § 101**

Claims 1-7, 10, 35, and 37 stand provisionally rejected as claiming the same invention as claims 11, 15, 20, 30-34, 37, and 45 of co-pending Application 10/601,269 (Docket No. H-203315 (8540R-000001)). Applicants respectfully traverse the rejection because the rejected claims do not claim the same invention as the co-pending application.

First, Applicants note the rejection is a provisional rejection since the conflicting claims have not been patented. The Examiner's attention is drawn to a reply mailed February 28, 2006, in co-pending 10/601,269 (Applicants' Docket No. H-203315 (8540R-000001)). The co-pending application is being examined by the current

Examiner. Applicants' arguments given below are consistent with those made in the co-pending Application.

For statutory ( §101) double patenting rejections, a reliable test is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*. The test is whether there is an embodiment of the invention that falls within the scope of one claim, but not the other. If, there is such an embodiment, then statutory double patenting would not exist. See *generally* MPEP § 804.II.A.

For convenience of reference, the rejected claims are shown in the right hand column of the following table, with the co-pending claims shown in the left hand column (Table A).

TABLE A

<p align="center"><b>USSN 10/601,269</b>  <b>(H-203315; 8540R-000001)</b>  <b>Claims 11, 15, 20, 30-34, 37, and 45</b></p>	<p align="center"><b>USSN 10/601,250</b>  <b>(GP-302786; 8540R-000002)</b>  <b>Claims 1-7, 10, 35, and 37</b>  <b>Rejected under §101 for claiming the</b>  <b>same invention as</b>  <b>(10/601,269) 11, 15, 20, 30-34, 37, and 45</b></p>
<p>11. (original) An automotive body panel comprising:  a gel coat layer;  a laminate layer; and  a barrier coat disposed between the gel coat and the laminate layer,  wherein the barrier coat comprises a polyester resin and reinforcing fibers of length 1 mm or less.</p> <p>15. (original) A body panel according to claim 11, wherein the laminate layer comprises a dicyclopentadiene resin and glass fibers of 6 mm in length or greater.</p>	<p>1. A method for preparing a composite by spray up operation, comprising the steps of:  applying a gel coat into a mold;  applying a barrier coat over the gel coat; and  applying a laminate formula over the barrier coat,  wherein the laminate formula comprises 40-80% by weight paste and 20-60% by weight reinforcing fibers, wherein the paste comprises 70% or more by weight resin, up to 25% by weight filler, and an initiator composition;  wherein the resin comprises an unsaturated polyester resin curable at a temperature of 50°C</p>

<p>20. (previously amended) A barrier coat composition comprising:  a resin component comprising:  80-100 parts of dicyclopentadiene resin and up to 20 parts of an isophthalic acid resin, and  a reinforcing fiber component comprising fibers having a length of 1 mm or less mixed with the resin component.</p> <p>28. (previously amended) A method for preparing a composite article by spray up operation, comprising the steps of:  applying a gel coat into a mold;  applying a barrier coat over the gel coat in the mold; and  applying a laminate formula over the barrier coat,  wherein the laminate formula contains 20-60% by weight of first reinforcing fibers having a first length of 6 mm or greater and 40-80% by weight of a paste comprising a laminate coat polyester resin;  wherein the barrier coat comprises second fibers having a length less than the first length dispersed in a barrier coat polyester resin.</p> <p>30. (previously amended) A method according to claim 28, wherein the thickness of the composite article is from 2 to 15 mm.</p> <p>31. (previously amended) A method according to claim 28, wherein the composite article is an automotive body panel.</p> <p>32. (previously amended) A method according to claim 28, wherein the laminate formula fiber comprises polymeric hollow microspheres.</p> <p>33. (currently amended) A method according to claim 28, wherein the first reinforcing fiber comprise glass fibers of 12 mm or greater in length or a second fibers comprise</p>	<p>or lower; the filler comprises particles having a density lower than that of the resin, and the initiator composition contains an optional promoter or accelerator, the initiator composition being capable of initiating cure of the resin at a temperature of 50°C or lower.</p> <p>2. A method according to claim 1, wherein the gel coat is 0.2-2 mm thick, the barrier coat is 0.5-5 mm thick, and the laminate is 1-10 mm thick.</p> <p>3. A method according to claim 1, wherein the thickness of the composite is from 2-15 mm.</p> <p>4. A method according to claim 1, wherein the composite is an automobile body panel.</p> <p>5. A method according to claim 1, wherein the filler comprises glass hollow microspheres.</p> <p>6. A method according to claim 1, wherein the filler comprises polymeric hollow microspheres.</p> <p>7. A method according to claim 1, wherein the paste comprises 90% or more by weight resin and up to 5% by weight polymeric hollow microspheres.</p> <p>10. A laminate composition comprising a paste and filler, wherein the paste comprises,  a dicyclopentadiene unsaturated polyester resin;  polymeric hollow microspheres; and  an initiator composition capable of initiating curing at a temperature of 50°C or less,  and wherein the filler comprises reinforcing fibers having a length greater than or equal about 6 mm.</p> <p>34. A method according to claim 30, wherein the laminate resin composition comprises 90% or more by weight polyester resin and up to 5% by weight polymeric hollow microspheres.</p>
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<p>glass fibers of 1 mm or less in length.</p> <p>34. (previously amended) A method according to claim 28, wherein the barrier coat polyester resin comprises 75-100 parts of a dicyclopentadiene resin and 1-25 parts of an isophthalic acid resin.</p> <p>35. (currently amended) A method of producing an automotive body panel comprising the steps of:</p> <p style="padding-left: 40px;">applying a gel coat composition to mold surface;</p> <p style="padding-left: 40px;">applying a barrier coat composition to the gel coat in the mold;</p> <p style="padding-left: 40px;">applying a fiber reinforced laminate composition comprising fibers having a first length onto the barrier coat and the mold;</p> <p style="padding-left: 40px;">curing at 50°C. or less; and</p> <p style="padding-left: 40px;">removing the cured article from the mold,</p> <p style="padding-left: 40px;">wherein the barrier coat comprises polyester resin and glass fibers having a second length shorter than the first length.</p> <p>37. (previously amended) A method according to claim 35 wherein the barrier coat exhibits elongation at break of 1% or greater.</p> <p>43. (previously amended) A method according to claim 35, comprising the steps of applying the gel coat to a thickness of 0.5-2 mm, applying the barrier coat to a thickness of 1-3 mm, and applying the laminate coat to a thickness of 2-5 mm.</p>	<p>35. A method according to claim 34, wherein the polyester comprises a dicyclopentadiene resin.</p> <p>36. An automobile body panel, comprising a cured multilayer composite article comprising:</p> <p style="padding-left: 40px;">a gel coat layer;</p> <p style="padding-left: 40px;">a laminate layer; and</p> <p style="padding-left: 40px;">a barrier layer disposed between the gel coat layer and the laminate layer,</p> <p>wherein the laminate layer comprises reinforcing glass fibers in a matrix of a cured polyester resin, wherein the matrix comprises up to 5% by weight of polymeric hollow microspheres and the polyester resin comprises a dicyclopentadiene polyester resin.</p> <p>37. A body panel according to claim 36, wherein the glass fibers are greater than or equal to about 12 mm in length.</p>
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From the claims on the left hand versus the right hand column, it is readily seen that many embodiments of the invention that fall within the claims of the right hand column would not infringe the claims in the left hand column, and vice versa.

For example, claim 11 in the left column is drawn to an automotive body panel. Such an automotive body panel would not infringe the method claim 1 in the right hand column, and vice versa. As another example, many of the other claims in the left hand column recite a limitation that the barrier coat contains fibers of less than 1 mm in length. Such a limitation is found in none of the claims on the right hand side. For these and many other reasons, Applicants respectfully submit that the rejected claims do not claim the same invention as claims 11, 15, 20, 30-34, 37, and 45 of Serial 10/601,269. For this reason, Applicant respectfully requests that the statutory double patenting rejection under 35 U.S.C. § 101 of the claims be withdrawn.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 16-19, 22-24, and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by GB Patent No. 1 493 547. Applicants respectfully traverse the rejection and request reconsideration.

As a preliminary matter, Applicants wish to retract their earlier position that the GB Patent '547 did not disclose a gel coat layer. However, Applicants maintain their position that the GB Patent '547 does not disclose at least one limitation of the rejected claims. Specifically, the GB Patent '547 does not disclose a "barrier layer disposed between the gel coat and the laminate" as recited in all of the rejected claims. Because the reference fails to disclose at least one limitation of the claims, rejection under § 102 is improper. If the Examiner means to maintain his position that the reference anticipates the claim, he is respectfully requested to point out the location in the GB '547 patent that discloses the barrier layer of the claims.

For the reasons discussed above, Applicant respectfully requests the rejection of the claims as anticipated by the GB '547 patent be withdrawn.

**REJECTION UNDER 35 U.S.C. § 102 – *EX PARTE* PFEIFFER**

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as anticipated by the Okayama reference (JP 2001/150559). The Examiner has taken the position that the limitations to the laminate formula recited in claim 1 should receive no weight for patentability under the principles of *Ex parte* Pfeiffer. Applicants traverse the rejection and request reconsideration.

Applicants respectfully submit that the claimed limitations in the rejected claims are “manipulatively distinct” over the cited art. As developed in earlier replies by Applicants, *Ex parte* Pfeiffer does not apply to situations like the current one. It is clear from consideration of the current claimed steps that the step of “applying a laminate formula” is manipulatively distinct. In particular, the laminate formula is of a particular recited composition. Applying the formula over the barrier coat necessarily involves manipulatively distinct steps. For example, applying the laminate formula necessarily involves providing the recited paste, reinforcing fibers and initiator composition, followed by applying the laminate formula over the barrier coat. The rejected claims in *Ex parte* Pfeiffer, on the other hand, merely recited the physical properties or limitations of the bag that was being dropped. Because the recited structure of the bag did not change the step of dropping, the structural limitations of the claims were given no patentable weight. Here, on the other hand, the “structural limitations” recited in the claim, i.e., the composition of the laminate formula” necessarily involves manipulatively distinct steps in providing the formula and applying it over the barrier coat, as discussed.

Applicants urge that *Ex parte* Pfeiffer is not applicable to the current claims. Accordingly, Applicants respectfully requests the rejection be withdrawn.

**REJECTION UNDER 35 U.S.C. § 103**

Claims 10 and 25 are rejected as unpatentable over the Okayama reference in view of the GB Patent '547. Applicants respectfully traverse the rejection and request reconsideration.

As discussed above, application of the Okayama reference to claims 1-8 for anticipation is improper. For the reasons discussed above, claims 1-8 are patentable over the Okayama reference. Applicant believes the Examiner intends to imply the combined references to claim 9 instead of claim 10. For reference, claim 9 (added by Preliminary Amendment, June 20, 2003) reads as follows:

“9. A method according to claim 1, wherein applying the laminate formula comprises operating a spray gun in a side-to-side motion until a desired thickness of laminate is obtained.”

Applicants do not understand the Application of the combined claims to claim 25. Claim 25 depends from claim 16, which is not rejected over the references.

Nevertheless, it is Applicants' position that in view of the inapplicability of *Ex parte* Pfeiffer to claims 1-8, the current rejection of claim 9 as obvious over the combined references, must also be withdrawn. Accordingly, Applicant respectfully requests the rejection be withdrawn.

Claims 10-15, 20, 27-29 are rejected as obvious over the GB Patent '547 in view of the Maker reference (U.S. 5,087,405). The cited GB patent is said to teach the claimed invention including a laminate composition, including an unsaturated polyester resin, initiator material, and filler of specific dimensions, citing to page 1, lines 30-36,

and page 3, lines 72-83 of the GB '547 patent. While the GB '547 patent does not recite polymeric hollow microspheres, the Maker reference is said to provide this teaching. Applicants respectfully traverse the rejection and request reconsideration.

The GB '547 patent does not disclose the use of a dicyclopentadiene unsaturated polyester resin as recited in claim 10. As stated in the Office Action, the reference GB'547 patent also fails to teach the inclusion of polymeric hollow microspheres in the composition.

The Maker reference does not provide a teaching of the use of polymeric hollow microspheres as recited in the rejected claims. Combining its teaching with GB '547 does not produce the claimed invention. The Office Action holds to a different reading of Maker, citing to column 11, lines 1-15. That passage of Maker is recited here for reference:

“EXAMPLE NO. 11

All cited examples of in-mold overlays require either:

1. A neutral barrier gel coat for pigmented overlays, or
2. A pigmented barrier gel coat for clear overlays.

The neutral or pigmented barrier gel coats may be eliminated in the manufacture of synthetic marble with a mixture of unsaturated polyester resin and marble dust (calcium carbonate). Example No. 11 describes the composite of the synthetic marble composite.

A clear cellulose acetate butyrate (CAB) overlay coating was prepared as follows:”

As can be seen from the passage, it teaches a mixture of “unsaturated polyester resin and marble dust (calcium carbonate)”. Applicants respectfully submit this teaching does not describe or suggest polymeric hollow microspheres. In the first place, marble dust



is not polymeric. As plainly stated in the passage it is made of calcium carbonate, an inorganic material. In the second place, dust is not made of "spheres" or "microspheres". As is well known, dust is the product of grinding or milling; dust particles take on a variety of shapes and are not limited to spheres. Third, even if the dust can be thought of as made in-part of "spheres", there is no teaching or suggestion that such "spheres " are or ought to be hollow. The reference just does not teach what it said to teach in the Office Action. Along these lines, Applicants would like to point out that Maker does not disclose the use of "marble like particles" as stated in Section 8 of the Office Action. That is, the Maker reference does not teach particles in the shape of a marble, it teaches particles made of marble dust. As noted, such teaching is not of a "polymeric hollow microsphere" as recited in the rejected claims.

The teaching of the Maker reference is also deficient concerning claim 14. In particular, Maker does not teach calcium carbonate coating in column 11, lines 10-49. There is simply no teaching in the cited passage of polymeric hollow microspheres covered with a calcium carbonate coating.

Applicants do not understand the application of the combined references to claim 20. Applicants note that claim 20 depends from claim 16; claim 16 is not subject to rejection. Likewise, claims 27-29 depend from claim 16 which is not subject to rejection. If such rejections have not been made in error, Applicants respectfully request that the Examiner clarify his position. Along these lines, Applicant also does not understand the reference in the last lines of Section 8 of the Office Action to claims 38-39. According to the heading of the section, claims 38 and 39 are not rejected.

In light of the remarks above, Applicants respectfully request clarification and/or withdrawal of the claim rejections.

Claim 21 is rejected as obvious over the Japanese Patent and the GB '547 patent as applied to claims 10 and 25 above in view of the Maker reference. Maker is cited for its teaching of a thermoset resin. Applicants respectfully traverse the rejection and request reconsideration.

Whatever the teaching of the Maker reference, it does not overcome the deficiencies of the references as applied to claims 10, 25, and 21. The deficiencies of the reference as applied to claims 10 and 25 are discussed above. Applicant respectfully submits that the Maker reference does not make up for those deficiencies. Accordingly, Applicant respectfully requests the rejection be withdrawn.

Claims 30-32, 34 and 35 are rejected as obvious over the Okayama reference in view of the Maker reference. In the Office Action, it is conceded the primary reference does not teach the aspect of hand laying recited in the claims. However, the Office Action takes the position that such a deficiency of the primary reference is made up by the teachings of the Maker reference.

Contrary to the assertion in the Office Action, the Maker reference does not teach or describe the step of handling a glass cloth on top of the barrier coat layer as recited in the rejected claims. Attention is drawn to the cited passage of the Maker reference, i.e., column 2, lines 64-65 and column 3, lines 3-14. On closer inspection, it is seen that these passages in the reference refer to spraying or brushing the gel coat onto the surface of a mold. The reference does not teach spraying or brushing the laminate. Further, spraying or brushing a gel coat on the surface of a mold is certainly not the same operation as handling a glass cloth on top of a barrier layer and applying a laminate resin composition to the glass cloth as is recited in the rejected claims.

It is Applicants position that the combined references do not teach what is asserted in Section 10 of the Office Action. The Examiner is urged to reconsider and withdraw the rejections.

Claim 33 is rejected as obvious over the Maker reference and GB '547 patent as applied to claims 30-32 and 34 above, and further in view of the Okayama reference. Applicants respectfully traverse the rejection and request reconsideration.

The deficiencies of Maker and GB '547 with respect to claims 30-32 and 34 are discussed above. Applicants respectfully submit the Okayama reference does not make up for those deficiencies. Accordingly, Applicant respectfully requests the rejection be withdrawn.

## CONCLUSION

Applicant believes the cited references have been applied improperly against the claims of the current application. Applicant respectfully requests the Examiner reconsider the rejections in light of the comments above. Alternatively, Applicants respectfully request an Advisory Notice stating whether the remarks can be considered at this time. Although no interview is available to the Applicants as of right, the Examiner is invited to telephone the undersigned Applicants' representative if that would expedite prosecution or be helpful to resolving any issues.

Respectfully submitted,

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